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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/505,052	02/16/2000	Donald R. Russell	P96005US2B	6415

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EXAMINER

HORTON, YVONNE MICHELE

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 11/27/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/505,052

Applicant
DONALD R. RUSSELL ET AL.

Examiner
YVONNE M. HORTON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 16, 2001
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above, claim(s) 25 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. Newly submitted claims 25 and 26 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The method of applying a walkway pad does not require the particulars of the roof deck, specifically the insulation nor the steps of constructing a roof deck.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25 and 26 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6,7 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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4. Claims 6,7 and 13 recites the limitation "said step of removing", respectively, in lines 3. There is insufficient antecedent basis for this limitation in the claims. The step of stripping was introduced however the step of removing was not introduced. Perhaps the applicant intends to reference the step of stripping. Clarification and correction is required.

5. Claims 14 and 15 recites the limitation "100% solids tape", respectively, in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1,2, 8-10 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #3,903,340 to SHEPHERD. In reference to claims 1,8 and 24, SHEPHERD discloses a method for applying a walkway pad (10) to a roofing membrane including the step of affixing a solids tape (28) to a flat surface of the pad (10) at the manufacturing location wherein the tape has a release paper (30); stripping the release paper; placing the exposed tape onto the roof membrane; and inherently applying pressure. In reference to claims 2 and 10, the walkway pad comprises asphaltic materials, column 2, line 61. Regarding claim 9, the tape (28) is applied proximal to opposing edges, see Figure 1.

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8. Claim 27 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #3,903,340 to SHEPHERD. SHEPHERD discloses a method of making walkway pads (10) including the step of inherently constructing the pad in a factory and applying a solids tape also at the factory.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 6,7 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #3,903,340 to SHEPHERD. As detailed in paragraph #6 above, SHEPHERD discloses the basic claimed method, except for the steps of preparing and priming. In reference to claims 6,7 and 13, although SHEPHERD is silent with respect to the steps of preparing and priming

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the roof surface, these steps are old and well known in the art. Hence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to prepare and prime the roof surface prior to stripping the release paper. Regarding claims 14 and 15, the 100% solids tape (28) is applied at the location of manufacture.

12. Claims 3 and 11 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #3,903,340 to SHEPHERD in view of US Patent #4,855,172 to CHIU or commercially available adhesive tapes by ADCO PRODUCTS, INC tape 510 or 303 and ASHLAND CHEMICAL tape 408. As detailed in paragraph #6 above, SHEPHERD discloses the basic claimed method of applying a walkway pad except for the solids including EPDM. CHIU; ADCO PRODUCTS, INC.; and ASHLAND CHEMICAL each teach the use of an adhesive for roofing products including EPDM. Hence, regarding claims 3 and 11, it would have been obvious to one having ordinary skill in the art to provide the structure of SHEPHERD with the EPDM adhesives of either CHIU; ADCO PRODUCTS, INC.; and ASHLAND CHEMICAL in order to improve the adhesion of the walkway pad to the roof and to improve securement of the pads thereto. Further the applicant is reminded that an article or element must effect the method in a manipulative sense in order to be given patentable weight in a method claim.

13. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #3,903,340 to SHEPHERD, as applied to claim 1, in view of US Patent #4,855,172 to CHIU or commercially available adhesive tapes by ADCO PRODUCTS, INC tape 510 or 303

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and ASHLAND CHEMICAL tape 408 and FIRESTONE RUBBERGARD Walkway pad. SHEPHERD discloses the basic claimed method except for the particulars of the walkway pad and adhesive. FIRESTONE RUBBERGARD Walkway pad teaches that it is known to form a walkway pad out of a rubber blend and CHIU or commercially available adhesive tapes by ADCO PRODUCTS, INC tape 510 or 303 and ASHLAND CHEMICAL tape 408 teaches the use of EPDM adhesives for rubber based pads. Thus, it would have been obvious to one having ordinary skill in the art to form the walkway pad of SHEPHERD out of the material of FIRESTONE RUBBERGARD and form the adhesive of SHEPHERD out of CHIU or commercially available adhesive tapes by ADCO PRODUCTS, INC tape 510 or 303 and ASHLAND CHEMICAL tape 408 in order to improve the adhesion of the walkway pad to the roof and to improve securement of the pads thereto. The applicant is reminded that on page 8 of his specification he discloses that any type of walkway pad may be used and that the invention is not limited to the selection of a particular walkway pad. Hence, the applicant has shown no criticality for the type of walkway pad used in his method. Further, the applicant is reminded that an article or element must effect the method in a manipulative sense in order to be given patentable weight in a method claim. Thus the type of walkway pad and adhesive has not been given patentable weight.

14. Claims 16,17 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #3,903,340 to SHEPHERD. Regarding claim 16, SHEPHERD discloses the method of providing walkway pads to service personnel including the steps of preparing a self-adhering

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pad (10), affixing a solids adhesive (28) and release paper (30) and bundling the pads, column 4, line 56, by stacking. SHEPHERD discloses the basic claimed method except for the step of delivering. Although SHEPHERD is silent with respect the delivery step, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the stacked pads would be delivered for use. In reference to claim 17, the walkway pads are asphaltic, column 2, line 61. Regarding claims 20-23, the tape (28) is a solid tape that is applied to the proximal ends of the pad (10), see Figure 1, at the location of manufacture. In further regards to claim 22, applying the solids tape without priming the surface would have been an obvious matter of design skilled labor choice.

15. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #3,903,340 to SHEPHERD in view of US Patent #4,855,172 to CHIU or commercially available adhesive tapes by ADCO PRODUCTS, INC tape 510 or 303 and ASHLAND CHEMICAL tape 408. As detailed in paragraph #13 above, SHEPHERD discloses the basic claimed method of applying a walkway pad except for the solids including EPDM. CHIU; ADCO PRODUCTS, INC.; and ASHLAND CHEMICAL each teach the use of an adhesive for roofing products including EPDM. Hence, it would have been obvious to one having ordinary skill in the art to provide the structure of SHEPHERD with the EPDM adhesives of either CHIU; ADCO PRODUCTS, INC.; and ASHLAND CHEMICAL in order to improve the adhesion of the walkway pad to the roof and to improve securement of the pads thereto. Further the applicant is

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reminded that an article or element must effect the method in a manipulative sense in order to be given patentable weight in a method claim.

16. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #3,903,340 to SHEPHERD, as applied to claim 16, in view of US Patent #4,855,172 to CHIU or commercially available adhesive tapes by ADCO PRODUCTS, INC tape 510 or 303 and ASHLAND CHEMICAL tape 408 and FIRESTONE RUBBERGARD Walkway pad. SHEPHERD discloses the basic claimed method except for the particulars of the walkway pad and adhesive. FIRESTONE RUBBERGARD Walkway pad teaches that it is known to form a walkway pad out of a rubber blend and CHIU or commercially available adhesive tapes by ADCO PRODUCTS, INC tape 510 or 303 and ASHLAND CHEMICAL tape 408 teaches the use of EPDM adhesives for rubber based pads. Thus, it would have been obvious to one having ordinary skill in the art to form the walkway pad of SHEPHERD out of the material of FIRESTONE RUBBERGARD and form the adhesive of SHEPHERD out of CHIU or commercially available adhesive tapes by ADCO PRODUCTS, INC tape 510 or 303 and ASHLAND CHEMICAL tape 408 in order to improve the adhesion of the walkway pad to the roof and to improve securement of the pads thereto. The applicant is reminded that on page 8 of his specification he discloses that any type of walkway pad may be used and that the invention is not limited to the selection of a particular walkway pad. Hence, the applicant has shown no criticality for the type of walkway pad used in his method. Further, the applicant is reminded that an article or element must effect the method in a manipulative sense in order to be given

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patentable weight in a method claim. Thus the type of walkway pad and adhesive has not been given patentable weight.

Response to Arguments

17. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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patentable weight in a method claim. Thus the type of walkway pad and adhesive has not been given patentable weight.

Response to Arguments

17. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (703) 308-1909.

Yvonne M. Horton
Art Unit 3635
November 19, 2001


Carl D. Friedman
Supervisory Patent Examiner
Group 3600